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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,728	06/18/2001	Yoichiro Tomari	1163-0341P	8265

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EXAMINER

ALAUBAIDI, HAYTHIM J

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/881,728

Applicant(s)

TOMARI ET AL.

Examiner

Haythim J. Alaubaidi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This is a first Non-Final Action in regard to Application No. 09/881,728 filed on June 16, 2001.
2. Claims 1-17 are presented for examination, of which Claims 1, 9, 13 and 17 are Independent.
3. Claims 1-17, are rejected under 35 U.S.C. 102(e).
4. Claim 3, is rejected under 35 U.S.C. 112, second paragraph.

***Priority***

5. Applicant's claim for foreign priority under 35 U.S.C. §119(a)–(d) is acknowledged, the Applicant was accorded the benefit of the earlier filing date of November 10, 1999.

***Claim Rejections - 35 USC § 112***

6. Claim 3, is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The repeated use of the term "history information" is clouding up the invention, for example "said information history list display section displays the history information in connection with the history information about that history information".

Examiner asserts that all claims should be checked for clarification. Appropriate action is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-17, are rejected under 35 U.S.C. 102(e) as being anticipated by Bryan I-chuen Lee (U.S. Patent No. 6,212,553 and Lee hereinafter).

Regarding Claim 1, Lee discloses an information history list display section for displaying history information<sup>1</sup> of communication (Figure 14 and 35 and corresponding text) in connection with a processing state of the history information in accordance with history related information<sup>2</sup> indicating the processing state of the history information (Figure 14, i.e. status; see also Col 5, Lines 49-56).

Regarding Claim 2, Lee discloses

a history management section for recording the history information about communication; (Col 8, Lines 60-64)

and an information management table for recording the history related information (status) that indicates the processing state of the history information

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<sup>1</sup> Please note that the Examiner is interpreting the "history information" to be the same as an "e-mail message". This is according to the Specification of the current application (see page 1, Lines 15-17).

<sup>2</sup> Please note that the Examiner is interpreting the "history related information" to be the same as a "status" of n e-mail.

stored in said history management section (Col 5, Lines 57-64; see also Col 23, Lines 16-37).

Regarding Claim 3, Lee discloses wherein said information management table records relationships between the history information (e-mail) and said information history list display section (Col 5, Lines 57-64; see also Figure 14 and associated text).

Regarding Claim 4, Lee discloses plurality of different communication means (Figure 1, Element 12 and 13; see also Col 13, Line 49).

Regarding Claim 5, a personal address book for recording a personal name of a communication party (Figure 3, Element 335; see also Col 13, Line 52) and a communication address of the communication party (Col 13, Line 52 ); and an address book search section for searching said personal address book (Col 17, Lines 24-39) wherein said information history list display section displays the personal name in substitution for the communication address included in the history information stored in said history management section in accordance with a retrieval result from said personal address book by said address book search section (Figure 14 and corresponding text, i.e. the names of the ~~names of the~~ senders under the "From" column displays the personal name, such as, "Bob Winters" in substitution for the communication address (e-mail address).

Regarding Claim 6, Lee discloses wherein said information history list display section receives the history information (e-mails) and the history related information (status) from a server (Col 9, Lines 8-10).

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Regarding Claims 7 and 8, the limitations of these claims are similar in scope to the rejected claims 2 and 6, above. They are therefore rejected as set forth above.

Regarding Claim 9, Lee discloses a server comprising: a personal information management section (address book with personal info) for transmitting, in response to a request, information to said information terminal (Col 17, Lines 24-38).

Regarding Claims 10-12, the limitations of these claims have been noted in the rejection of claim 9, above. In addition, Lee discloses:

a history management section for recording the history information about communication; (Col 8, Lines 60-64)

and an information management table for recording history related information that indicates a processing state of the history information stored in said history management section (Col 5, Lines 57-64; see also Col 23, Lines 16-37).

Regarding Claims 13-16, the limitations of this claim has been noted in the rejection of claims 1, 2 and 3, above.

Regarding Claim 17, Lee discloses:

recording history information about communication (Col 8, Lines 60-64)

recording history related information indicating a processing state of the history information (Col 5, Lines 57-64; see also Col 23, Lines 16-37)

and displaying the history information in connection with the processing state of the history information in accordance with the history related information (Figure 14, i.e. status; see also Col 5, Lines 49-56).

***Other Prior Art Made of Record***

9. a. Shuman (U.S. Patent No. 6,424,995) discloses a method for displaying information contained in an electronic message;
- b. Kennedy (U.S. Patent No. 6,134,582) discloses a system and method for managing electronic mail messages using a client-based database; and
- c. Ulrich et al. (U.S. Patent No. 6,052,735) discloses an electronic mail object synchronization between a desktop computer and mobile device.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

***Points of Contact***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haythim J. Alaubaidi whose telephone number is (703) 305-1950. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

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Any response to this office action should be mailed to:

The Commissioner of Patents and Trademarks, Washington, D.C. 20231 or telefax at  
our fax number (703) 872-9306.

Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6<sup>th</sup>  
Floor Receptionist, Arlington, Virginia. 22202.

*Haythim J. Alaubaidi*

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Patent Examiner  
Technology Center 2100  
December 28, 2003



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AU 2171